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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,958	01/16/2001	Gilbert Dominguez	10323-9004-00	5489
23409	7590	02/23/2004	EXAMINER	
MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202			SCHLAK, DANIEL K	
		ART UNIT	PAPER NUMBER	
		3653		

DATE MAILED: 02/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/760,958	DOMINGUEZ, GILBERT
	Examiner Daniel K Schlak	Art Unit 3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 29 January 2003.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-14 and 16-23 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) _____ is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) 1-14,16-23 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

DETAILED ACTION

Note from Examiner

The prosecution to date has been reviewed by the Examiner. In light of the Appeal Brief and other arguments, and upon review of the prior Examiner's limited prima facie case for combination of references, the present Examiner upholds Applicant's assertions that a prima facie case was not made by the Examiner. Also, after review of the cited art, the present Examiner has no choice but to deem that it is wholly unlikely that the most pertinent art is of record in the Application.

Thus, the present Examiner is going to tentatively withdraw *all* rejections under 35 U.S.C., and thus, as applicant has amended all claims rejected under 35 U.S.C. 102 to incorporate recitations from claims only rejected under 35 U.S.C. 103, *all* of the rejections presented by the Office to this point are moot.

Prosecution will begin anew. A new search will be performed, and the claims evaluated for patentability subsequently.

However, in light of Jones and prior rejections under 35 U.S.C. 102, it is clear that the nature of the recitations in the claims pertaining to the speed-of-loading rating are of utmost importance in determining the scope of the claims and their patentability. As all of the independent claims put forth such recitations in different ways, and as all of the independent claims pertain to various environments, specific or not, the claims are restrictable as follows:

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, drawn to method for using a speed of loading rating and other parameters to assign location to item to be sorted, classified in class 700, subclass 215.
- II. Claims 9-14, drawn to apparatus for loading containers utilizing only non-speed-of-loading parameters, classified in class 700, subclass 224.
- III. Claims 16-23, drawn to method for controlling a robotic system, classified in class 700, subclass 245.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process could be performed by a person sitting on a floor with three containers. The person, the containers being of different sizes and shapes, could look at them and determine that one of them is small enough to require undue time to insert a large object into it, thereby affecting his/her decision to assign that location to that object. The Examiner emphasizes that Group I is the *only* group that actually uses the speed-of-loading rating in making any decision. Invention II could practice a process that never uses speed-of-loading in making any decision

whatsoever. Further, the apparatus utilizes cells/locations "having" speed-of-loading ratings, apparently determined before sorting begins, there being no recitation to specify otherwise, while the process actively assigns the speed-of-loading during the creation of a scheme.

Inventions III and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case Invention II could be used to practice a method not involving a robotic system or robotic cells. Invention III could be practiced without a controller connected to a database; by a human operator controlling the robot, for instance. Invention III further involves the "picking up" of items, while such is neither explicit nor inherent in Invention II. For instance, Invention II could involve "dropping" of items via gravity.

Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as utilizing a speed-of-loading rating in making an assignment of location decision. Invention II has separate utility such as using a robot and picking objects up. See MPEP § 806.05(d).

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required in full for Group II, restriction for examination purposes as indicated is proper. Group II only uses the code in scheme and projected/historical numbers of items in making the decision, which establishes it as a general sorting apparatus.

Because these inventions are distinct for the reasons given above and the search required for Group III is not required in full for Group I or for Group II, restriction for examination purposes as indicated is proper. Robot systems and control methods therefore lie outside the scope of general sorting operations.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306 - 4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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